

REMARKS

Reconsideration of this application, in view of the amendment, is respectfully requested.

Applicants gratefully acknowledge that the Examiner has kindly withdrawn the rejection of Claims 39 and 45-47 under 35 U.S.C. § 103(a).

The Examiner has maintained the restriction requirement but has not yet defined the extent of the elected and non-elected subject matter. Upon determination of allowable subject matter, the Examiner has indicated that he will review the claims and indicate the generic concept that will comprise the elected subject matter. Additionally, the Examiner has generously offered to reconsider the rejoinder of the process claims. While the Examiner's proposals are greatly appreciated, it is not clear as to what exactly comprises the elected subject matter and to what extent the Examiner will rejoin claims, making a complete response to an upheld restriction requirement somewhat difficult. For example, the Examiner has withdrawn Claim 39 from consideration but the record shows that this claim has definitely been previously searched and examined. The Examiner has also withdrawn Claims 29-38 from consideration but, on closer examination, it is seen that these claims pertain to and depend from Applicant's elected Group I, Claims 1-14. It is therefore believed that the Examiner may not have intended to withdraw Claims 29-39 from consideration.

Plus, an online search of previous patents granted by the Examiner has revealed a willingness to keep methods of using compounds in the same case as claims drawn to compounds and at least one process of preparation. Hence, there is a possibility that upon determination of allowable subject matter, the Examiner may be willing to reconsider the rejoinder of the method of use Claims 48-52 in addition to process Claims 1-14 and 29-39.

Consequently, the present amendment has been geared towards the claimed subject matter that might reasonably comprise the elected, allowable subject matter from the Examiner's point of view. In a good faith attempt to move this application along to an allowance, non-elected Claims 40-44 and 15-28 have been canceled. Claim 32 has also been canceled and the limitations of this dependent claim have been incorporated into amended Claim 1. Pending the Examiner's final decision on the restriction requirement, Applicants reiterate that they reserve the right to file a divisional application directed to the nonelected subject matter of this invention.

The Examiner rejects Claims 1-14 and 45-47 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. For reasons set forth on pages 3 and 4 of the Office action, the Examiner asserts that heterocyclic substituted derivatives are not enabled by the specification. While Applicants disagree with the merits of the rejection, Claim 1 has been amended to expedite matters and to conform the scope of the claims to the process of making the compounds containing only the cycloheteroalkyl ring as taught in the specification.

The Examiner has previously implied that claims limited to the instance where R₁ and R₂ form a piperidine ring would be allowable. The Examiner also indicates that claims limiting the scope to those actually disclosed and a generic concept that includes structurally related species would be allowed. It is conceivable that the Examiner may now find that the cycloheteroalkyl ring of the amended claim will be enabled by the working examples of the piperidine derivatives in the specification. Certainly, one of ordinary skill in the art would consider that other claim-designated cycloheteroalkyl rings could be readily substituted for the piperidine ring without undue experimentation.

Applicants respectfully request that this present amendment, albeit after a final rejection, be considered and entered in the record. This amendment was not previously presented because it was believed in good faith that Applicants' prior arguments would suffice. Since those prior remarks did not convince the Examiner, Applicants are amending the case to place the application in condition for an immediate allowance based on the Examiner's hints at allowable subject matter or, at the very least, to simplify the issues on appeal. In effect, the heterocyclic substituted derivatives are no longer an issue and the Examiner's justification for the sole rejection of the application pursuant to 35 U.S.C. § 112, first paragraph, is rendered moot by the present amendment. Applicants therefore hope that the Examiner will enter the amendment, reconsider the rejection of record and allow the pending claims.

In view of the amendment and the foregoing remarks, Applicants respectfully request that the rejection of Claims 1-14 and 45-47 under 35 U.S.C. § 112, first paragraph, be withdrawn and the application be held allowable.

Accordingly, this application is now in condition for an allowance. Favorable treatment is respectfully urged.

Respectfully submitted,

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